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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,505	10/11/2005	Lutz Brahmig	BRAHMIG ET AL 1 PCT	6748
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WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER SINHA, RITA K	
			ART UNIT 3609	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,505	Applicant(s) BRAHMIG ET AL.	
	Examiner Rita K. Sinha	Art Unit 3609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10-11-2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary amendments submitted on 10/11/05 have been entered.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: the upper deflection device, 3 and the lower deflection device, 4 (described on page 19, but not shown in drawings). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.
2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the upper deflection device (3) and the lower deflection device (4) as claimed by claims 1, 3, 4, 5 and 8. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "4.1" and "2" are pointing to the same part, which appears to be the "lower winding shaft, 2". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 1-9 are objected to because of the following informalities: In claim 1, the term "A" is missing at the beginning of the preamble so that it states "A large surface advertising device for posters", and also the usage of "winding shafts" in parenthesis is improper. Correct claim language requires only the usage of characters/numbers inside of parenthesis.

In claim 2, the term "A" is missing at the beginning of the preamble so that it states "A method for controlling the poster change..."

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In claims 3-9, the term "The" is missing at the beginning of the preambles so that is states "The large-surface advertising device for posters according to claim 1".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 2 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. The claims begin by discussing a method, and the body of the claims discusses the specifics of a system. "A claim of this type is precluded by the express language of 35 U.S.C 101 which is drafted so as to set forth the statutory classes of invention in the alternative only." See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990). Explicitly

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the claim is directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. It is therefore unclear whether Applicant is claiming a process or a machine. See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

As per claim 1, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "particularly" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "supply rollers to accommodate rollable posters in web form", and the claim also recites "particularly poster change devices for alternating advertising" which is the narrower statement of the range/limitation.

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Claim 1 also recites the limitation "the" once in Line 8 and twice in Line 9. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests using the term "a" instead.

Claim 2 recites the limitation "the" once in Line 1, once in Line 2, twice in Line 4, once in Line 6, once in Line 8 and twice in Line 9. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests using the term "a" instead.

Regarding claim 2, the word "means" is preceded by the word(s) "of" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

As per claim 3, "and/or" is found once on Line 4. This word usage is incorrect and warrants these claims as indefinite. Examiner suggests to only use the word "and" for this case.

Claim 4 recites the limitation "the" incorrectly twice in Line 4. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests using the term "a" instead.

Regarding claim 5, the word "means" is preceded by the word(s) "of" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

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As per claim 7, "and/or" is found twice on Line 4. This word usage is incorrect and warrants these claims as indefinite. Examiner suggests to only use the word "and" for this case.

As per claim 8, "and/or" is found twice on Line 5. This word usage is incorrect and warrants these claims as indefinite. Examiner suggests to only use the word "and" for this case.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simson (5,517,778), and further in view of Jones et al (6,467,207).

As per claim 1, Simson discloses a large-surface advertising device (banner display apparatus, 5) for posters, having a housing (housing, 6), in which supply winding shafts (drive shafts, 15) to accommodate rollable posters (scroll, 12) in web form are disposed, particularly poster change devices for alternating advertising, whereby the housing is provided with a transparent viewing pane (viewing panel, 11), and light sources (back lighting, 95) are disposed behind or in front of the poster (See Figure 14), wherein at least one upper and lower deflection device (floating rollers, 16) is disposed on the housing mount and base frame, at the top and bottom (See Figure 2).

However, Simson fails to disclose that the winding shafts are mounted in front of the deflection devices.

Jones et al. disclose the concept of a winding shaft (roller, 32) mounted in front of a deflection device (roller, 34) on the housing (support, 22) of a display device (display apparatus, 10) (See Figure 1).

From this teaching of Jones et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the winding shafts of Simson to include the positioning of the winding shafts of Jones et al. for the purpose of enabling a more taut grip on the rollable posters by the winding shafts.

As per claim 2, Simson discloses a method for controlling the poster change (via motors, 17) by means of controlling the winding shafts, wherein the speeds of rotation of the upper and lower winding shaft are controlled as a function of their current diameter during the winding process (See Column 3 Lines 3-12), in such a manner that a freely hanging constant poster loop forms during the-poster change, independent of the winding direction, and after the target position of the poster has been reached, the loop is wound up by means of defined rewinding of one of the upper or lower winding shafts, and the poster is tensed/stretched tight (See Column 3 Lines 36-47).

As per claim 3, Simson further discloses the upper deflection device and/or the lower deflection device consists of a shaft (axial spindle, 27) that is mounted in at least two locations (See Figures 2 and 3).

As per claim 4, Simson further discloses the looping angle of the poster web at the upper and lower deflection device and is less than 270 degrees (See Figure 4).

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As per claim 5, Simson further discloses the upper and lower deflection devices are supported once or multiple times on the housing mount and base frame, by means of supports (oval slot, 28). (See Figure 3; Column 3 Lines 28-34)

As per claim 9, Simson further discloses that all of the individual parts for poster holding and poster change are disposed in duplicate (See Figure 2).

11. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simson (5,517,778) in view of Jones et al (6,467,207) as applied to claim 1, and further in view of Simson et al (6,247,256).

As per claims 6 and 7, the Simson and Jones combination discloses an upper and lower winding shaft, but fails to disclose that the upper and lower winding shaft are replaceable and changed multiple times in a changing magazine.

Simson et al. disclose the concept of replaceable shafts (rollers, 30 and 31) and the concept of the shafts able to be replaced multiple times. (See Column 2 Lines 62-67)

From this teaching of Simson et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shafts of the Simson and Jones combination to include the replaceable shafts of Simson et al. for the purpose of ensuring longevity of product performance.

As per claim 8, the Simson and Jones combination discloses upper and/or lower deflection devices, but fails to disclose counter-elements that act at a slant disposed on the upper and lower deflection device.

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Simson et al. disclose the concept of slanted counter-elements (leaf springs, 17 and 18) that are disposed on upper and lower deflection devices (rollers, 30 and 31). (See Figure 1)

From this teaching of Simson et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the upper and lower deflection devices of the Simson and Jones combination to include the slanted counter-elements of Simson et al. for the purpose of facilitating easy removal and replacement of the deflection devices.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ilkka et al. (5,638,625) discloses an information board having information mounted on wind-up rolls. Aiken Sr. (5,410,830) discloses a scrolling sign for menu display unit having a viewing window and scrolling web.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita K. Sinha whose telephone number is (571) 270-3027. The examiner can normally be reached on M-F 730-500; alt Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571) 270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RKS

 4/30/07
LYNDA JASMIN
SUPERVISORY PATENT EXAMINER